

REMARKS

This is in response to the Official Action mailed on December 21, 2004. Claims 1-21 are pending and claim 1 has been amended.

Section 102(e) Rejection of Claims 1-21

According to the Patent Office, claims 1-21 are anticipated by U.S. Patent No. 6,657,702 of Chui et al. ("Chui"). The Office cites to particular portions of Chui in support of its position, but Applicant respectfully disagrees that the features recited in independent claims 1 and 18 are known from Chui.

The Chui patent describes a method for facilitating the *re-ordering* of photographic prints. Re-ordering is facilitated because the website contemplated by Chui has the host server maintaining an address book of recipients. This enables, among other features, the drag-and-drop interface shown in Figure 5 to readily permit the user to direct photographs to delivery addresses known to the Chui system. However, the arrangement taught by Chui is specific to that particular website, such that a user of Chui's system would have to establish an address book of recipients at multiple web sites to support that user's e-commerce transactions, or enter the address information of an intended recipient at each such website.

Discussion of Claim 1

The invention of claim 1 overcomes the deficiencies in Chui by utilizing an address book maintained on the user's client machine rather than at the host server as in Chui. Several advantages flow from this distinction. First, the user maintains control over an address book by combining at the client machine and then forwarding to the host server only that portion of his or her address book that concerns the persons for whom a selection of a gift item has been made. Second, the user can leverage the entries in his or her address book at multiple web sites using the claimed methodology without having to register potential gift recipients at each site. Third, the user can utilize his or her address book at multiple web sites without exposing any more of its address

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book contents than necessary to complete a commercial transaction for the benefit of persons identified in their address books. The amendments to claim 1 address these distinctions.

In contrast, Chui has its own database which presents stored entries as icons at one hosted website. This improves the art, according to Chui, by permitting a user to “order image prints to be distributed to multiple recipients while minimizing the user’s time, effort, and expense in placing an order.” Chui, column 2, lines 59-64. However, Chui does not recognize the problem addressed by the present invention or its solution. Chui has a user enter address book information of persons who may already be in an address book on the user’s client machine. In contrast, the methodology of claim 1 has the contents of the user’s address book made available at the client machine for interaction and use in completing an order selection form, thereby minimizing a user’s need to replicate information already contained in their personal address books. Further, the methodology of claim 1 enables the address book contents to be utilized across multiple web sites, with dissemination of the contents of the address book to the web site remaining under the user’s control at all times.

Because Chui stores the contact information for “re-ordering,” Chui also ignores an important privacy issue that may be important to users of his site. Although Chui’s system provides advantages in its own right, certain users may not wish their contact data to be stored any more than they might want their credit card information to be stored for later use. For such users of Chui’s site, Chui offers no solution to the data-reentry problem. In contrast, the methodology of claim 1 addresses the data-reentry problem while respecting a user’s privacy concerns. By enabling a user to instruct the website not to store the contact data for later use (the same as with credit card information). Yet that user can leverage his or her address book to facilitate reorders without having to re-enter data by instead utilizing the invention of claim 1 to combine at the client’s machine his or her address book into the selection form.

In view of the foregoing, Applicant submits that Chui does not utilize an address book maintained on the client machine to retrieve at least a set of names, does not combine in a selection form at the client machine a gift item with any set of names of potential gift recipients, and does not

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forward to the host server only that portion of an address book which concerns the set of names after having been combined into the selection form at the client machine. Accordingly, Applicant submits that Chui does not anticipate the method of claim 1. Further, insofar as Chui is not directed to the problem or the solution of maintaining control over the user's address book at the client machine and completing selection forms at the client machine using that data before forwarding to the host server, Chui does not render the methodology of claim 1 obvious.

Reconsideration and withdrawal of the Section 102(e) rejection against claims 1-17 is respectfully requested.

Independent Claim 18

Applicant submits that independent claim 18 distinguishes patentably over Chui generally for the reasons noted above, and further because Chui does not teach or suggest the downloading and use of a component at the client machine, as claimed.

The claimed component is downloaded to the client machine in step (a) and utilized in step (b) to retrieve address book entries. Chui does not utilize such a component, nor is there any reason to modify Chui to utilize such a component at the client machine because the address book entries of Chui originate from Chui's web server. The downloading of the component is used in the methodology of claim 18 to perform address book extraction for sites that do not have permission or ability to access address books through a conventional web browser interface. Accordingly, Chui does not anticipate the method of claim 18. Further, insofar as Chui is not directed to the problem of providing downloadable components that interact with address books that are remote from the Chui web server or the act of retrieving into such a component contents of any remotely maintained address book, Chui does not render the methodology of claim 18 obvious.

Reconsideration and withdrawal of the Section 102(e) rejection against claims 18-21 is respectfully requested.

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